

REMARKS

The following remarks are submitted in response to the final Office Action mailed May 15, 2007. Reconsideration of the application is respectfully requested. In light of the following arguments and current amendments to the claims, Applicant

- 5 respectfully requests withdrawal of the finality of the present rejection, entry of the claims as currently amended, and passage of the application to allowance. Applicant contends that final rejection of its application is premature in that, for various reasons described below, the Examiner and Applicant have failed to develop a clearly defined issue upon which to base either the final rejection or an
10 appeal.

Amendments to Claims

Claims 1, 16-17, 32-35, 39-41, and, 45-50 have been amended to correct various
15 grammatical errors, to ensure consistent terminology and to provide proper antecedent basis. No new matter has been added through these amendments. However, Applicant has amended each of the above claims to clarify that the claimed invention is directed to an "online" purchase transaction, which Applicant contends, among other things, causes the claimed invention to be patentably
20 distinguishable from the disclosure of the cited prior art, and consequently, overcomes the current rejections. Each of the parent independent claims is directed to an "online" purchase transaction, and hence, all dependent claims are likewise directed to an "online" purchase transaction, which Applicant contends is not present or disclosed by the cited prior art. Consequently, Applicant asserts
25 that Claims 1-50 are therefore allowable.

Applicant's Response to Examiner's "Response to Arguments"

The Examiner has indicated that Motoyama describes "user not present" but then
30 fails to explain how the "account movement transaction" of Motoyama discloses "user not present" other than reference to an "automatic bill payment account

agreement". Applicant's invention is not an automatic bill payment service. Further, Applicant submits that Motoyama fails to disclose the features and functionality of an automatic bill payment service. Since it is apparent that the "automatic bill payment account agreement" mentioned in Motoyama is the

- 5 principal basis for the Examiner's rejections, Applicant contends that it is essential that the Examiner support the supposition of the teaching of Motoyama concerning automatic bill payment and that the Examiner correlate the purported teaching to the elements of the claimed invention as arranged in the claim. Until the Examiner has done so, the Applicant is disadvantaged.

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Although Motoyama references an "automatic bill payment account agreement" with the bank, Motoyama does not describe significant detail associated with the functional features of this agreement, nor, does it describe any aspect that might anticipate the elements of the claimed invention. Instead, Applicant respectfully

- 15 submits that the Examiner has relied on his own personal perception of the features and functionalities of an automatic bill payment service which might be provided by a bank without supporting such perception with adequate evidentiary support.

- 20 Applicant respectfully points out that the Abstract of Motoyama states that Motoyama discloses "a financial information intermediary system" which extracts product information supplied by financial institutions for presentation to a client. Motoyama does not contemplate no disclose supporting online purchase transactions when a user is not present.

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Further, in an earlier Advisory Action dated 05/01/2006 and a subsequent previous Office Action dated 08/15/2006, the Examiner has asserted that Motoyama discloses, in reference to "user not present", the following functionality associated with the "automatic bill payment account agreement" referenced in

- 30 Motoyama (emphasis added):

5 "A client sets up an agreement with a bank. Once the client has an
agreement with the bank, the bank pays bills **online** on behalf of
the client. All payments made by the bank, on behalf of the client,
are made without a live authenticated session with the client. The
bank will release the necessary funds to pay the client's bills
without having a live authenticated session with the client."

- 10 First, Applicant wishes to point out that this description cannot be located within
the disclosure of Motoyama, and therefore, it is clear that the Examiner must be
relying on extrinsic evidence. Second, the Examiner has provided no evidentiary
support for this assertion and hence, Applicant presumes that this conclusory
statement is based on personal knowledge of the Examiner, which may be
tainted by hindsight. Third, Applicant contends that it is presumptive for the
Examiner to assume that the bank paid bills "online." Motoyama makes no such
15 reference. Automatic bill pay can consist of a bank simply cutting a manual
check which may then be mailed to the particular party to be paid. Again,
Motoyama does not disclose a delegation of trust or authentication for an "online
purchase transaction" when a user is not present, as in the claimed invention.
- 20 Applicant contends that it is much too great a leap for the Examiner to expand
the limited disclosure of Motoyama to arrive at an unsupported presumption of
anticipation of the claimed invention based on the brief reference to an automatic
bill payment account. Applicant respectfully traverses the present rejections and
asserts that the subject claims are patentably distinguishable from the disclosure
25 of Motoyama, at least for Motoyama's failure teach the completion of an online
transaction when a user is not present. Further, Applicant contends that the
single reference of Motoyama fails to teach or enable each of the claimed
elements of Applicant's invention as arranged in Applicant's claims.
Consequently, Applicant submits that the Examiner has failed to establish a
30 *prima facie* case of anticipation under §102(b) and hence, the rejection of all of
Claims 1, 2, 5-12, 16-18, 21-28, and 32-50 is deemed overcome.

35 U.S.C. §102(b).

Claims 1, 2, 5-12, 16-18, 21-28, and 32-50 stand rejected under 35 U.S.C.

- 5 §102(b) as being anticipated by Motoyama U.S. Patent No. 5,913,202 (herein "Motoyama"). Claims 1, 17, 33, 39, and, 45 are those independent claims which stand rejected.

Applicant respectfully traverses the Examiner's rejection of the above

- 10 independent and dependent claims. Applicant incorporates prior responses herein, in particular, descriptions of the disclosures of cited references and descriptions of the claimed invention.

Applicant reproduces Claim 1, below, as currently amended, for convenience to

- 15 clearly point out that the invention of Claim 1 is distinguishable from the disclosure of the prior art, Motoyama. For clarity, Applicant's arguments will be directed first to rebuttal of the rejection of Claim 1. However, the arguments presented will be equally applicable to Applicant's rebuttal of the rejections of the additional independent Claims 17, 33, 39 and 45.

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Claim 1. An apparatus for proving authentication when a user is not present, said apparatus comprising:

a **Web service client** coupled to a **Web service provider**;
an **online wallet** configured to store and selectively release financial

25 information of said user; and

a discovery service;

wherein:

said Web service client, said Web service provider, and said discovery service agree to work with each other; and

30 an act of releasing financial information of said user from said online wallet to fund an **online purchase transaction** on behalf of said user without a live authenticated session of said user with the Web service client is conditioned upon receiving proof of

authority to conduct the requested online purchase transaction without the live authenticated session.

Applicant submits that Motoyama fails to disclose any of a Web service client; a

- 5 Web service provider, an online wallet, a discovery service, and, an online purchase transaction.

In his "Response to Arguments", at pages 2 - 4 of the present Office Action, the

10 Examiner has argued that Motoyama anticipates the claimed invention due to a reference to a process for moving an automatic bill payment account agreement from a first bank to a second bank. Applicant contends that the "automatic bill payment" account described in Motoyama does not disclose the claimed invention. The claimed invention is directed to and describes an apparatus for providing an "authentication" mechanism to execute an "online" purchase

- 15 transaction when the "user is not present." Motoyama does not describe such an apparatus and merely discusses how another bank account can be selected for use in paying regular, known bills from a known entity, in this case, a utility provider.

- 20 Applicant respectfully traverses the Examiner's presumptions concerning disclosure associated with the mere mention of an automatic bill payment service described in Motoyama. The Examiner has failed to take proper official notice of facts not in the record, and, has improperly relied on purported common knowledge. In either circumstance, the MPEP clearly establishes that "official notice" should only rarely be relied on when an application is under final rejection as in the present case.

Applicant contends that the Examiner's unsupported conclusions concerning the capabilities of an automatic bill payment service described in Motoyama are

- 25 neither well-known nor capable of instant and unquestionable demonstration as being well-known, and, are therefore, not supportable by taking of official notice.

The purported facts concerning the features and functionality of the automatic bill payment service referenced with brevity in Motoyama are not capable of such instant and unquestionable demonstration as to defy dispute. Further, the presumption of functionality associated with the automatic bill pay service

- 5 referenced in Motoyama is not of notorious character. Automatic payment of a bill does not presume that the payment transaction occurs online. Additionally, such automatic payment is not equivalent to completion of an online purchase transaction requiring authentication when the user is not present, as disclosed in the claimed invention. As disclosed, the automatic bill pay service of Motoyama
- 10 does not support authentication for completing an online purchase transaction when the user is not present.

Additionally, in the present case, the undocumented conclusion drawn by the Examiner concerning the functionality of the automatic bill pay service is not used

- 15 to simply “**fill in the gaps**” which might exist in the Examiner’s evidentiary showing to support his particular ground of rejection. The undocumented conclusion or presumption of the functionality and features of the automatic bill pay service is **fundamental** to the Examiner’s basis for rejection, and therefore, **the Examiner must provide evidentiary support for his assertions in the written record.**
- 20

Since the Examiner intends to rely on his presumption of the undisclosed features and functionality of an automatic bill pay service referenced in Motoyama, Applicant submits that the Examiner is required to support his

- 25 presumptions by citation to some reference work recognized as standard in the art. It is well recognized that the facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable persons and hence, are not amenable to the taking of official notice. Here, the Examiner has presumed certain functionality to be present in the automated bill
- 30 pay service of Motoyama, and, here, implies such functionality to be common knowledge. Given that the Examiner relies on this assumption as his principal

evidence and basis for the present rejections, the Examiner must supply evidentiary support in the record. He cannot simply reach conclusions based on his own understanding or experience, particularly when that understanding may be tainted by hindsight or the inappropriate application of today's recognized

- 5 state of the art to yesterday's circumstances.

Further, since the Examiner has impliedly taken official notice of the functionality and structure of the automatic bill pay system of Motoyama, he is required to present the **explicit basis** on which he regards the matter as subject to official

- 10 notice. Further, he must present the explicit basis in **sufficient detail** to allow the Applicant to challenge the assertion. The Examiner has not afforded Applicant the opportunity to challenge the Examiner's assertions by providing adequate evidentiary support for those assertions.

- 15 Applicant contends that the present rejections by the Examiner are based on the Examiner's reliance on factual assertions which have neither been properly officially noticed nor properly based upon common knowledge. Consequently, Applicant respectfully traverses the Examiner's rejections based upon improper reliance on the factual assertions associated with the Examiner's own description
20 of functionality of the automatic bill payment system of Motoyama. In particular, Applicant contends that Motoyama's automatic bill payment reference does not address performing an online purchase transaction. In fact, all that we know of the automatic bill payment service of Motoyama is that the service can be transferred to another bank to access funds in a different account. Motoyama
25 provides no other further disclosure, and therefore, cannot possibly anticipate the claimed invention.

Formal Request for Examiner's Affidavit/Declaration

- 30 Having adequately traversed the Examiner's use of what he appears to contend is common knowledge concerning automatic bill payment, Applicant submits that

the Examiner must provide documentary evidence of his assertions to maintain the present rejections. Since it is clear that the Examiner has relied on personal knowledge to support his finding as to what is known in the art, the Examiner must provide **an affidavit or declaration setting forth specific factual**

- 5 **statements and explanation to support his findings** concerning the purported functionality of the automatic bill payment system referenced in Motoyama.

Consequently, Applicant respectfully requests that the Examiner provide such an affidavit or declaration to support his findings concerning the

- 10 **purported functionality and features of the automatic bill pay service referenced in Motoyama.**

As provided in MPEP 2144.03, "It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal

- 15 evidence upon which a rejection was based." As further provided in MPEP 1.104 (d) (2) – Nature of Examination, Citation of References, "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, 20 and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons."

Applicant also submits that the Examiner appears to have implicitly relied on a presumed **inherent or implicit disclosure** of Motoyama concerning the automatic

- 25 bill pay service. In that case, the Examiner must provide rationale or evidence tending to show inherency (MPEP §2112.) The fact that a certain characteristic **may** be present in the prior art is insufficient to establish the inherence of that characteristic. Here, Applicant contends that the Examiner has failed to provide extrinsic evidence that makes clear that the missing descriptive matter 30 concerning his description of the automatic bill pay service of Motoyama is necessarily present in the mere mention of the automatic bill pay service

described in Motoyama. Further, the Examiner has failed to provide extrinsic evidence that would clearly establish that the purported functionality of the Motoyama automatic bill pay service would be so recognized by persons of ordinary skill in the art. **Inherency may not be established by probabilities or possibilities**, as Applicant contends Examiner has done in the present Office Action.

Under the presumption that the Examiner is relying upon a theory of inherency, once again, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, Motoyama.

Applicant contends that the teachings relied on by the Examiner concerning the automatic bill pay service do not flow from Motoyama and that Motoyama is incapable of providing the same features and functionality as that of the claimed invention. In particular, Motoyama fails to teach or suggest the execution of an online purchase transaction when a user is not present, as does the claimed invention.

Further, as provided in 37 CFR §1.104, Applicant is entitled to presume that the Examiner has carried his burden of citing the best references at his command. According to 37 CFR § 1.104 Nature of examination, (c) (2), reproduced herein below, when a reference is complex, the particular part relied on must be designated as nearly as practicable. 37 CFR § 1.104 is show herein below as follows:

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(c) *Rejection of claims.*

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.

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When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied**

on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (Emphasis added.)

- 5 Applicant submits that the Examiner has failed to carry his burden of clearly explaining the basis for his rejection of each claim. Respectfully, Applicant submits that the Examiner has used a process of simply repeating Applicant's claims in their entirety and then providing references in Motoyama to passages which purportedly disclose the elements of that particular claim.
10 Applicant respectfully submits that the Examiner has failed to properly correlate the elements of the claimed invention with purportedly disclosed elements in Motoyama. In Applicant's previous responses to earlier office actions, Applicant has pointed out various passages in Motoyama cited by the Examiner which fail
15 to disclose the particular features of the particular claim to which the passages are directed. Under these circumstances, it is difficult ... if not impossible ... for Applicant to clearly understand the rationale and basis for the Examiner's rejections. In the present Office Action, the Examiner has essentially reiterated his earlier arguments which once again fail to cite relevant passages in
20 Motoyama. As such, Applicant respectfully requests that the Examiner reconsider his arguments and provide Applicant with additional clarification and more specific citations to applicable disclosure in Motoyama, if available, as to how Motoyama actually discloses or teaches the elements of the claimed invention, arranged in the same manner.
25 Considering Applicant's concerns and arguments, above, Applicant respectfully asserts that the Examiner has failed to comply with the requirements of 37 CFR § 1.104 Nature of examination, (c) (2).
30 Further, Applicant asserts that the Examiner has likewise failed to comply with the requirements of MPEP §706.07, 37 CFR §1.113 (b) requiring the Examiner to

repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof. Applicant contends that the Examiner has failed to clearly develop the grounds for rejection, in this and earlier Office Actions, to the extent that Applicant may readily judge the

- 5 advisability of an appeal. Additionally, Applicant contends that the Examiner has failed to fully develop the reasons for the basis of the rejections, and instead, has relied on a mere conclusion of what might be present in the prior art of Motoyama.

- 10 Applicant respectfully submits that the Examiner has used a stereotyped procedure for formulating his rejections, forcing Applicant to carry the burden of somehow associating the Examiner's references with the elements of each of Applicant's claims. Given that Applicant has been unable to find those elements in many of the reference passages cited by the Examiner, Applicant submits that
15 the procedure used by the Examiner is more of a template approach with little substance in the rationale. As stated in MPEP 707.07(g), "Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression."

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On these issues alone, Applicant is of the opinion that the rejections are improper.

- In view of the above, Applicant has shown that the Motoyama reference does not
25 teach every element of the claim. Accordingly, Claim 1 and its respective dependent claims are deemed to be in allowable condition. Based on the same rationale, in view of the arguments hereinabove, Claims 17, 33, 39, and 45 and their respective dependent claims, are deemed to be in allowable condition.
Therefore, Applicant respectfully requests that the Examiner withdraw the
30 rejections under 35 U.S.C. §102(b).

35 U.S.C. §103(a).

Claims 3, 4, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Motoyama as applied to Claims 1 and 17 hereinabove, and

5 further in view of Van Oorschot *et al* ("Oorschot") U.S. Patent No. 5,699,431.

The rejection of Claims 3, 4, 19, and 20 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Claims 3, 4,

10 19, and 20 are dependent upon independent Claims which are deemed to be in

allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

Claims 13, 14, 29, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Motoyama as applied to Claims 1 and 17 hereinabove, and

15 further in view of Ramasubramani *et al* ("Ramasubramani") U.S. Patent No. 6,516,316 B1.

The rejection of Claims 13, 14, 29, and 30 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Claims 13,

20 14, 29, and 3 are dependent upon independent Claims which are deemed to be in allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

Claims 15 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable

25 over Motoyama as applied to Claims 1 and 17 hereinabove, and further in view of Yu U.S. Patent No. 4,919,545.

The rejection of Claims 15 and 31 under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments concerning Claim 1, above. Claims 15 and 31 are

30 dependent upon independent Claims which are deemed to be in allowable

condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

5

Conclusion

Applicant submits that Claims 1-50 are allowable for at least the reasons stated above. All rejections having been addressed, Applicant respectfully requests favorable consideration of the above remarks, withdrawal of the present 10 objections and rejections, and passage of Claims 1-10 and 12-33 to allowance. Applicant submits that the instant application is now in condition for allowance and respectfully solicits prompt notification of the same.

Should the Examiner deem it helpful to advance the instant application to 15 allowance, the Examiner is encouraged and cordially invited to contact Applicant's attorney at (650) 474-8400.

Respectfully submitted,

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